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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,714	08/22/2005	Trong-Nghia Nguyen-Dobinsky	GUL019-225663	8340

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WOLF, BLOCK, SCHORR & SOLIS-COHEN LLP
1650 ARCH STREET, 22ND FLOOR
PHILADELPHIA, PA 19103-2334

EXAMINER

KOWALEWSKI, FILIP A

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 11/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/524,714

Applicant(s)

NGUYEN-DOBINSKY ET AL.

Examiner

Filip A. Kowalewski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/15/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

The specification lack the appropriate headings. Appropriate correction is required.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 10 and 60. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is absolutely no reference in the specification to a locating module or a GPS module in the specification.

Claims 10-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification makes no reference to a locating module or a GPS module. Particularly, there is no reference as to how a GPS module is to be integrated into the universal adapter, what components it is to be in communication with, or how it is function in the system. Thus, one of ordinary skill in the art would not be able to practice the invention with a locating module or a GPS module without undue experimentation.

Claims 23-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

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had possession of the claimed invention. There is absolutely no reference in the specification to user modes.

Claims 23-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification makes no reference to user modes. Particularly, there is no reference as to what functions or purpose the different user modes would serve or what relationship user modes have to the structure and operation of the system. Thus, one of ordinary skill in the art would not be able to practice the invention with different user modes without undue experimentation.

Claims 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is absolutely no reference in the specification to the function module being used without the universal adapter.

Claims 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification makes no reference to the function module being used without the universal adapter. Particularly, there is no reference as to what functions or purpose the function module would serve without the universal adapter or how it would accomplish its function and purpose and relate to other elements within the system. Thus, one of ordinary skill in the art would not be able to practice the invention with function module used without the universal adapter without undue experimentation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "function module" is not defined explicitly in the specification or implicitly through its usage. Thus, the term renders the claim indefinite since one of ordinary skill in the art would not be able to ascertain the scope of the claim. Furthermore, the Examiner has interpreted the claim in a manner that would render the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984). Claims 2-28 are rejected due to their dependence upon claim 1 or subsequent incorporation of the term.

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Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "process module" is not defined explicitly in the specification or implicitly through its usage. Thus, the term renders the claim indefinite since one of ordinary skill in the art would not be able to ascertain the scope of the claim. Furthermore, the Examiner has interpreted the claim in a manner that would render the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984).

Claims 2-28 are rejected due to their dependence upon claim 1 or subsequent incorporation of the term.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "universal adapter" is not defined explicitly in the specification or implicitly through its usage. Thus, the term renders the claim indefinite since one of ordinary skill in the art would not be able to ascertain the scope of the claim. Furthermore, the Examiner has interpreted the claim in a manner that would render the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984).

Claims 2-28 are rejected due to their dependence upon claim 1 or subsequent incorporation of the term.

Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. The term "communication module" is not defined explicitly in the specification or implicitly through its usage. Thus, the term renders the claim indefinite since one of ordinary skill in the art would not be able to ascertain the scope of the claim. Furthermore, the Examiner has interpreted the claim in a manner that would render the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984).

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "two-knob controller" is not defined explicitly in the specification or implicitly through its usage. Thus, the term renders the claim indefinite since one of ordinary skill in the art would not be able to ascertain the scope of the claim. Furthermore, the Examiner has interpreted the claim in a manner that would render the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984).

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "easily operated in the same manner" is not defined explicitly in the specification or implicitly through its usage. Thus, the term renders the claim indefinite since one of ordinary skill in the art would not be able to ascertain the scope of the claim. Furthermore, the Examiner has interpreted the claim in a manner that would render the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984).

Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "locating module" is not defined explicitly in the specification or implicitly through its usage. Thus, the term renders the claim indefinite since one of ordinary skill in the art would not be able to ascertain the scope of the claim. Furthermore, the Examiner has interpreted the claim in a manner that would render the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984). Claim 12 is rejected due to its dependence upon claim 11.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "wherein the data transmission to the process module can just as easily be accomplished using hard-wired I/O connection" is unclear and not defined explicitly in the specification or implicitly through its usage. Thus, the limitation renders the claim indefinite since one of ordinary skill in the art would not be able to ascertain the scope of the claim. Furthermore, the Examiner has interpreted the claim in a manner that would render the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984).

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention. The limitation “a function to automatically register connected function modules” is unclear and not defined explicitly in the specification or implicitly through its usage. Thus, the limitation renders the claim indefinite since one of ordinary skill in the art would not be able to ascertain the scope of the claim. Furthermore, the Examiner has interpreted the claim in a manner that would render the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984).

Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term “acoustic/visual signal element” is not defined explicitly in the specification or implicitly through its usage. Thus, the term renders the claim indefinite since one of ordinary skill in the art would not be able to ascertain the scope of the claim. Furthermore, the Examiner has interpreted the claim in a manner that would render the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984).

Claims 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term “control element” is not defined explicitly in the specification or implicitly through its usage. Thus, the term renders the claim indefinite since one of ordinary skill in the art would not be able to ascertain the scope of the

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claim. Furthermore, the Examiner has interpreted the claim in a manner that would render the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984).

Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "can be easily operated through two of the four control elements located on the universal adapter concerning basic functions" is unclear and not defined explicitly in the specification or implicitly through its usage. Thus, the limitation renders the claim indefinite since one of ordinary skill in the art would not be able to ascertain the scope of the claim. Furthermore, the Examiner has interpreted the claim in a manner that would render the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984).

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "expanded in operation and configuration" is not defined explicitly in the specification or implicitly through its usage. Thus, the term renders the claim indefinite since one of ordinary skill in the art would not be able to ascertain the scope of the claim. Furthermore, the Examiner has interpreted the claim in a manner that would render the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984).

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Claims 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "user modes" is not defined explicitly in the specification or implicitly through its usage. Thus, the term renders the claim indefinite since one of ordinary skill in the art would not be able to ascertain the scope of the claim. Furthermore, the Examiner has interpreted the claim in a manner that would render the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984).

Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "a function to change the user mode" is unclear and not defined explicitly in the specification or implicitly through its usage. Thus, the limitation renders the claim indefinite since one of ordinary skill in the art would not be able to ascertain the scope of the claim. Furthermore, the Examiner has interpreted the claim in a manner that would render the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984).

Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "diagnostic and therapeutic plan monitoring and medical monitoring software" is not defined explicitly in the specification or implicitly through its usage. Thus, the term renders the claim indefinite since one of ordinary skill

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in the art would not be able to ascertain the scope of the claim. Furthermore, the Examiner has interpreted the claim in a manner that would render the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984).

Claim Rejections – 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-28 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,790,178 to Mault et al. (hereinafter Mault).

Mault discloses various physiological monitor modules (Col. 6 – Ln. 15-30) that interact with a PDA which serves as a universal adapter and process module (Col. 2 – Ln. 45-67). Alternatively, the process module may be located separate from the PDA (Col. 7 – Ln. 1-26). The physiological monitor modules include processors and memory (Col. 2 – Ln. 45-67). The physiological monitor modules measure various body parameters (Col. 4 – Ln. 15-40) It is inherent that the PDA comprises a processor and memory. The PDA automatically recognizes that module that is connected to it (Col. 4 –

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Ln. 55-60). The PDA includes module capable of recording voice (Col. 5 – Ln. 4-15), which is a form of biometric data, and video (Col. 18 – Ln. 23-27). The PDA comprises various user modes dependent upon which module is attached (Col. 4 – Ln. 15 – 40). The PDA includes various forms of connection options for transmission of data between the PDA and modules (Col. 4 – Ln. 40-56; Col. 5 – 40-55). The PDA includes the ability to communicate wirelessly (Col. 7 – Ln. 15-26). It is inherent from the disclosure that the PDA and modules must each have a battery. The PDA also includes GPS (Col. 1 – Ln. 1-30). The PDA includes health management software (Col. 6 – Ln. 60-65). Thus, all of the features of the claimed invention are either explicitly or inherently disclosed by Mault.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Filip A. Kowalewski whose telephone number is 571-272-5668. The examiner can normally be reached on Monday - Friday: 8am - 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Filip A. Kowalewski
November 5, 2006

Michael Astorino
Michael Astorino